

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-9, 11, and 12 are pending in this application. Independent Claims 1 and 5 have been amended to clarify the nature of the “sender” that was apparently objected to relative to Claim 1 in the outstanding Action without the introduction of any new matter.

The outstanding Office Action includes an objection to Claim 1, a rejection of Claims 1, 3-9, 11, and 12 under 35 U.S.C. §103(a) as being unpatentable over Naughton et al (U.S. Patent No. 6,020,881, Naughton) in view of Venkatraman (U.S. Patent No. 5,9956,487) Brown et al, Bambert et al, Schneier, Rohatgi et al (U.S. Patent No. 5,625,693, Rohatgi and Cahill, Jr. (U.S. Patent No. 5,428,784, Cahill).

RESPONSE TO CLAIM 1 OBJECTIONS

The objection to Claim 1 states that the recitation “whether a sender of said electronic mail is an authorized user” is improper because “[t]here is insufficient antecedent basis for this limitation in the claim.” However, the only part of this limitation that requires there to be antecedent basis is the recital of “said electronic mail” and there is clear antecedent basis for reciting “said electronic mail” to be found in the Claim 1 recitation of “reception means for receiving an electronic mail transmitted through a network by a sender.” It was noted that as “a sender” had also been previously recited here that the objection might involve a possible question as to the “sender” recitals. To remove any doubt, Claim 1 now recites -- whether a the sender of said electronic mail is an authorized user--. As a similar recital was noted in Claim 5, this recital was similarly corrected.

Application No. 09/059,765
Reply to Office Action of 04/23/04

As the present amendments to Claims 1 and 5 are essentially cosmetic in nature, it is believed that the present Amendment should be entered as it does not require further search or other new considerations.

REJECTION RESPONSE

The teachings and fair suggestions of Naughton have been misinterpreted in the outstanding Action. In this regard, while a communications medium 160 is mentioned and illustrated by Naughton, nothing is said as to this communication medium being the “internet” as presumed in the outstanding Action. Instead, given that external communication circuit 35 in the computer system 170 is for handling transmissions from 170 and receiving signals to 170 across the communications medium 160 (see column 8, lines 47-54), and that this communication circuit transmits and receives using well known local remote control technologies “such as radio waves, low power, cellular, infrared signals, or data signals carried on existing power lines” (see column 8, lines 55-58), it is clear that these are the possibilities being suggested for the communications medium 160, not the “internet.”

In this last respect, the subjective belief of the PTO as to the nature of medium 160 is not controlling as the reference itself must reasonably suggest that 160 is intended to represent the “internet.” The burden of the PTO is to demonstrate a *prima facie* case of obviousness by showing that the relied upon references teach all of the limitations of the claims without resort to speculation to fill gaps missing from reference teachings. Note the following from In re Warner, 154 USPQ 173, 178 (CCPA 1967):

A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual

Application No. 09/059,765
Reply to Office Action of 04/23/04

basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. To the extent the Patent Office rulings are so supported, there is no basis for resolving doubts against their correctness. Likewise, we may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness. [Emphasis added.]

Moreover, even if the “internet” could be shown to be reasonably suggested as to medium 160, the use of any of the merely alternative possibilities as to this medium does not change the nature of the control taught for either an audio cassette tape recorder or a video cassette recorder (VCR) in terms of the common functions of “play, stop, rewind, fast-forward, and record” noted at column 9, line 64- column 10, line 8. Thus, to whatever extent Naughton could be said to teach an intuitive graphical user interface that could control the functions of “play, stop, rewind, fast-forward, and record” on a VCR, these are not the remote timer control of the subject matter of the rejected claims.

As noted in In re Wesslau, 147 USPQ 391, 393 (CCPA 1965) "it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." Also note In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) as follows

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [reference teachings] would have suggested to those of ordinary skill in the art, the [reference teachings] cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference.

Application No. 09/059,765
Reply to Office Action of 04/23/04

It is believed to be clear that the rejection has engaged in such impermissible picking and choosing and improper reliance on abstractions of actual teachings relative to the selective lifting of communication medium 160 and VCR 39 from the disclosure of Naughton with total disregard for the full description of these devices and their functions presented by Naughton.

This selective choosing of isolated increments relating to the actual teachings of Naughton is carried over to the complete ignoring by the PTO of the teaching by Naughton of a basic operating principle requiring an “intuitive graphical user interface based upon a geographical map structure” including icons and other objects (like buttons) to be selected and manipulated by the user. See the abstract, the Summary Of The Invention (starting at column 3, line 12) and note the specifics of remote control of real world objects taught at column 3, line 58-column 4, line 5, for example. If Naughton where to be somehow converted to the claimed subject matter involving adding a control command to electronic mail to control a reservation function of a video recording device to reserve an operation time with such electronic mail having no provision for the Naughton “intuitive graphical user interface based upon a geographical map structure,” the changes required mitigate against any finding of an obvious modification as they require changing the basic operating principle of Naughton with a corresponding total redesign. See In re Ratti, 123 USPQ 349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Turning to Venkatraman, the first question raised is why the artisan with the Naughton “intuitive graphical user interface based upon a geographical map structure”

Application No. 09/059,765
Reply to Office Action of 04/23/04

before him would even consider consulting the disclosure of Web server-browser based access of a device via the web page user interface of Venkatraman. Under circumstances like these, it is well established that the PTO must explain reference selection as well as the reasons why combining such disparate teachings would be even considered. See In re Lee, 61 USPQ2d, 1430, 1434 (Fed. Cir. 2002) that requires the PTO to "explain the reasons one of ordinary skill would have been motivated to select the references and to combine them to render the claimed invention obvious."

The **REQUIRED** reasons why the artisan would then look to the disparate page 2 teachings of Brambert as to the FAST 500 AutoLoader tape backup device (that make no mention of e-mail, unlike the description of the "Oracle card" appearing above them) and the Brown discussion of e-mail nets are also missing. Similarly, the reasons to look to the general discussion of Schenier as to e-mail security and specific use of certificates in the interactive TV system taught by Rohatgi based upon some form of logical reasoning is also missing. Such a "logical reason apparent from positive, concrete evidence of record" (In re Regel, 188 USPQ 136, 139 n.5 (CCPA 1975)) must always be presented.

Instead of any "logical reason apparent from positive, concrete evidence of record," the outstanding Action seeks to substitute unsupported conclusions for concrete evidence like the improper official notice at page 5 that all home VCR's have timers. Play only VCRs have been sold that include no timers. Moreover, column 13, lines 1-14 teach a USER who must be present to read a TV schedule, not timer recording. Thus, the suggestion of obvious design at the top of page 5 of the outstanding Action is not based upon "concrete evidence of record" as the unsupported conclusions offered by the PTO are not evidence.

Application No. 09/059,765
Reply to Office Action of 04/23/04

See Lee at 61 USPQ2d 1434 noting that “conclusory statements . . . do not adequately address the issue of motivation to combine.”

As noted in the last response, Naughton, Venkatraman, Brown et al, Bambert et al, Schneier, and Rohatgi do not include, *inter alia*, any hint of an electronic mail indication from the network that no reservation for the requested reservation time has been made when there is an overlap of the requested reservation time with any previously entered reservation times with the remote terminal associated with the external video recording device providing the electronic mail indication of no reservation to the network. In an apparent attempt to cure this deficiency, the outstanding Action adds Cahill.

However, Cahill simply teaches a dynamic response to an electronic message is provided to a sender without requiring any additional action on the part of an addressee. Thus, when a message is received, a search is conducted on the addressee's electronic calendar and if an event is found in which a receipt time of the message falls between the start and stop time thereof, a response is provided to the sender to indicate that the person so addressed is unavailable. See the Cahill abstract. This teaching falls far short of teaching the above-noted electronic mail indication from the network that no reservation for the requested reservation time has been made when there is an overlap of the requested reservation time with any previously entered reservation times with the remote terminal associated with the external video recording device providing the electronic mail indication of no reservation to the network. The top of page 6 of the outstanding Action attempts to finesse this lack of a relevant teaching as to preventing a reservation of a recording time by once again resorting to speculation as to the reason why the artisan would adopt the Cahil teaching at all,much less

Application No. 09/059,765
Reply to Office Action of 04/23/04

any reason to select the Cahill reference to modify any of the other references and to also add an untaught timer for recording and commands to control it.

Furthermore, reviewing the number of the relied upon references and the total lack of presentation of logical reasoning based upon concrete reference evidence taken in context, it is clear that the rejection has done little more than suggest that as various subsystem parts of the overall claimed combination were known, this alone establishes obviousness. To the contrary, the PTO reviewing court stated in In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) the following rebuttal:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

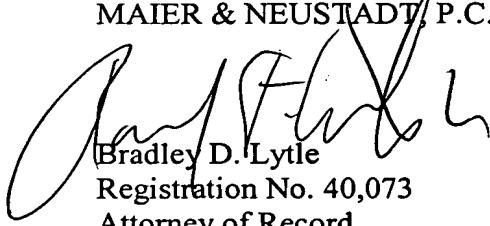
Accordingly, withdrawal of the outstanding rejection that violates court precedent is believed to be in order.

Application No. 09/059,765
Reply to Office Action of 04/23/04

As no further issues are believed to be outstanding in the present application, it is believed that the present application is in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Registration No. 40,073
Attorney of Record
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number

22850

BDL/RFC/jmp
Tel. no.: (703) 413-3000
Fax no.: (703) 412-2220